

ESTTA Tracking number: **ESTTA414907**Filing date: **06/16/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

|              |   |             |       |
|--------------|---|-------------|-------|
| Name         | Texas Taco Cabana, L.P.   |             |       |
| Entity       | Partnership   | Citizenship | Texas |
| Composed Of: | Taco Cabana Management, Inc., a Texas Corporation, sole general partner |             |       |
| Address      | 8918 Tesoro Drive Suite 200<br>San Antonio, TX 78217<br>UNITED STATES   |             |       |

|                      |   |
|----------------------|---|
| Attorney information | Mark I. Feldman<br>DLA Piper LLP (US)<br>203 N. LaSalle St. Suite 1900<br>Chicago, IL 60601<br>UNITED STATES<br>mark.feldman@dlapiper.com, ch.tm@dlapiper.com, erin.wright@dlapiper.com, mary.labeau@dlapiper.com |
|----------------------|---|

**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85207433  | Publication date       | 05/17/2011 |
| Opposition Filing Date | 06/16/2011  | Opposition Period Ends | 06/16/2011 |
| Applicant              | Taco Ana Franchising LLC<br>4673 Woodland Ave. #5<br>West Des Moines, IA 50266<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

|  |
|--|
| Class 043.<br>All goods and services in the class are opposed, namely: Restaurant services |
|--|

**Grounds for Opposition**

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

**Marks Cited by Opposer as Basis for Opposition**


|                       |             |                       |            |
|-----------------------|-------------|-----------------------|------------|
| U.S. Registration No. | 1581970     | Application Date      | 08/29/1988 |
| Registration Date     | 02/06/1990  | Foreign Priority Date | NONE       |
| Word Mark             | TACO CABANA |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         |   |
| Description of Mark | NONE  |
| Goods/Services      | Class 042. First use: First Use: 1987/06/15 First Use In Commerce: 1987/06/15 FAST FOOD, RESTAURANT SERVICES SPECIALIZING IN MEXICAN FOOD |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1726537  | Application Date      | 01/17/1992 |
| Registration Date     | 10/20/1992   | Foreign Priority Date | NONE       |
| Word Mark             | THE ORIGINAL TACO CABANA MEXICAN PATIO CAFE  |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1990/12/31 First Use In Commerce: 1990/12/31 fast food, restaurant services, specializing in Mexican food |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1778181   | Application Date      | 02/26/1992 |
| Registration Date     | 06/22/1993  | Foreign Priority Date | NONE       |
| Word Mark             | GET REAL GET TACO CABANA  |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1992/02/11 First Use In Commerce: 1992/02/11 restaurant services |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1978002                                     | Application Date      | 03/10/1995 |
| Registration Date     | 06/04/1996                                  | Foreign Priority Date | NONE       |
| Word Mark             | THE ORIGINAL TACO CABANA MEXICAN PATIO CAFE |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         |    |
| Description of Mark | NONE   |
| Goods/Services      | Class 030. First use: First Use: 1990/12/31 First Use In Commerce: 1990/12/31 prepared foods in the nature of Mexican cuisine, for consumption on or off premises, namely beef and chicken fajitas; bean and cheese, beef, and cheese nachos; cheese, beef, and chicken enchiladas; chicken, beef, fajita, carne quisada, and bean and cheese tacos; beef, chicken, and bean and cheese burritos; chorizo and egg, bacon, sausage, potato, bean and cheese, and barbacoa breakfast tacos; bean and cheese chalupas; pancakes; Spanish rice, tortillas, coffee, and tea |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1978245   | Application Date      | 05/26/1995 |
| Registration Date     | 06/04/1996  | Foreign Priority Date | NONE       |
| Word Mark             | THE ORIGINAL TACO CABANA TEX-MEX PATIO CAFE   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 restaurant services, specializing in Mexican food |                       |            |

|                     |                            |
|---------------------|----------------------------|
| Related Proceedings | Opposition Number 91200281 |
|---------------------|----------------------------|

|             |  |
|-------------|--|
| Attachments | 73748887#TMSN.gif ( 1 page )( bytes )<br>74238347#TMSN.gif ( 1 page )( bytes )<br>74645225#TMSN.gif ( 1 page )( bytes )<br>74680206#TMSN.gif ( 1 page )( bytes )<br>Taco Cabana Notice of Opposition.pdf ( 5 pages )(15619 bytes ) |
|-------------|--|

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

|           |                   |
|-----------|-------------------|
| Signature | /Mark I. Feldman/ |
| Name      | Mark I. Feldman   |
| Date      | 06/16/2011        |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Serial No. 85207433  
Mark: TACO ANA (and design)  
Published: May 17, 2011

|                                  |   |                             |
|----------------------------------|---|-----------------------------|
| <b>TEXAS TACO CABANA, L.P.,</b>  | ) |                             |
|                                  | ) |                             |
| <b>Opposer,</b>                  | ) |                             |
|                                  | ) | Opposition No.              |
| <b>v.</b>                        | ) |                             |
|                                  | ) | Mark: TACO ANA (and design) |
| <b>TACO ANA FRANCHISING LLC,</b> | ) |                             |
|                                  | ) |                             |
| <b>Applicant.</b>                | ) |                             |

**NOTICE OF OPPOSITION**

U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**TEXAS TACO CABANA, L.P.**, a Texas limited partnership, located at 8918 Tesoro Drive, Suite 200, San Antonio, Texas 78217 (hereinafter “Opposer”), believes that it would be damaged by registration of the mark shown in Application Serial No. 85207433 (“the ‘433 Application”), filed December 29, 2010, by Taco Ana Franchising LLC (hereinafter “Applicant”), published in the Official Gazette of the United States Patent and Trademark Office on May 17, 2011, and hereby opposes the registration of such mark.

The grounds for the opposition are as follows:

1. Opposer owns a chain of Mexican restaurants which feature menu items for breakfast, lunch and dinner. Opposer is well-known for its offerings in the fast food and restaurant fields.

2. Since well before the filing date of the '433 Application, Opposer has continuously used the mark TACO CABANA in interstate commerce in connection with its goods and services.

3. Opposer is the owner of numerous United States Trademark Registrations for the TACO CABANA mark and variations thereof (collectively referred to as the TACO CABANA Marks), including but not limited to the following:

| Mark  | Reg. No. | Goods   | Appl. Date | Reg. Date  |
|---|----------|---|------------|------------|
| TACO CABANA                                 | 1581970  | Fast food, restaurant services specializing in Mexican food     | 8/29/1988  | 11/14/1989 |
| THE ORIGINAL TACO CABANA MEXICAN PATIO CAFE | 1726537  | Fast food, restaurant services specializing in Mexican food     | 01/17/1992 | 10/20/1992 |
| GET REAL GET TACO CABANA                    | 1778181  | Restaurant services   | 02/26/1992 | 06/22/1993 |
| THE ORIGINAL TACO CABANA MEXICAN PATIO CAFE | 1978002  | Prepared foods in the nature of Mexican cuisine and other goods | 03/10/1995 | 06/04/1996 |
| THE ORIGINAL TACO CABANA TEX-MEX PATIO CAFE | 1978245  | Restaurant services specializing in Mexican food                | 05/26/1995 | 06/04/1996 |

4. Opposer's foregoing registrations for the TACO CABANA Marks are valid, subsisting, and nearly all are incontestable pursuant to 15 U.S.C. § 1065.

5. Opposer has used and is using the TACO CABANA Marks in interstate commerce in connection with the goods and services described in Opposer's foregoing registrations.

6. On December 29, 2010, Applicant filed the '433 Application based on an intent to use the mark TACO ANA (and design) for "restaurant services."

7. Opposer's use and registration of its TACO CABANA Marks long pre-date the filing date of the '433 Application.

8. The grant of a registration to Applicant for the TACO ANA (and design) mark as sought in the '433 Application should be denied on the grounds of Opposer's prior use of the TACO CABANA Marks. The mark sought to be registered by Applicant is confusingly similar to Opposer's TACO CABANA Marks, and the use of the TACO ANA mark by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's services are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

9. The grant of a registration to Applicant for the TACO ANA mark as sought in the '433 Application should be denied based on likelihood of confusion with Opposer's prior TACO CABANA Marks.

**WHEREFORE**, Opposer files this Notice of Opposition and prays that the aforesaid application of Applicant herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The filing fee of \$300.00 for one class and any additional fees required for this Notice of Opposition should be charged to Deposit Account No. 18-2284. Please address all correspondence regarding this opposition to:

Mark I. Feldman, Esq.  
DLA PIPER LLP (US)  
P.O. Box 64807  
Chicago, Illinois 60664-0807  
(312) 368-4000  
mark.feldman@dlapiper.com  
erin.wright@dlapiper.com  
ch.tm@dlapiper.com

June 16, 2011

Respectfully submitted,

**TEXAS TACO CABANA, L.P.**

By: /Erin E. Wright/  
Mark I. Feldman  
Erin E. Wright  
DLA PIPER LLP (US)  
P.O. Box 64807  
Chicago, Illinois 60664-0807  
(312) 368-4000

Attorneys for Opposer



**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to Emily Harris, Taco Ana Franchising LLC, 4673 Woodland Ave #5 West Des Moines, Iowa 50266 on June 16, 2011.

/Erin E. Wright/  
Signature

Erin E. Wright  
Name

6/16/11  
Date of Signature  
Date of Signature